

REMARKS

Summary of the Office Action

Claim 19 stands objected to because of an informality.

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view of *Endo et al.* (USPN 6,016,174).

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view of *Endo et al.* (USPN 6,016,174) and further in view of Applicants' allegedly admitted prior art.

Claims 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view of Applicants' allegedly admitted prior art.

Summary of the Response to the Office Action

Claims 1-5 have been canceled without prejudice or disclaimer to materially reduce and/or simplify the issues for appeal. Withdrawn claims 10-18 have been canceled. Claim 19 has been amended. Accordingly, upon entry of this paper, claims 6-9 and 19-20 are pending.

Objection to the Claims

Claim 19 stands objected to because of an informality. Applicants have amended claim 19 as suggested by the Examiner to correct the informality. Accordingly, Applicants respectfully request that the objection to claim 19 be withdrawn.

The Rejections Under 35 U.S.C. § 103(a)

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view of *Endo et al.* (USPN 6,016,174). Claims 6-9 stand rejected

under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view of *Endo et al.* (USPN 6,016,174) and further in view of Applicants' allegedly admitted prior art. Claims 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view of Applicants' allegedly admitted prior art. Applicants traverse the rejections for at least the following reasons.

i. Claims 1-5

Claims 1-5 have been canceled without prejudice or disclaimer to materially reduce and/or simplify the issues for appeal. Accordingly, the rejection of claims 1-5 is moot.

ii. Claims 6-9 and 19-20

With respect to independent claims 6 and 19-20, Applicants respectfully submit that there is no motivation to combine the grinding area of Applicants allegedly admitted prior art with the teachings of *Watanabe et al.* and/or *Endo et al.* Here, the Office Action has asserted that "it would have been obvious for one of ordinary skill in the art at the time of the invention to have a grinding area in the pad structure of *Watanabe* because *APA* teach that this is conventional in the art." Applicants respectfully disagree.

In the Final Office Action dated September 24, 2004, the Examiner asserts that "[i]t would have been obvious for one of ordinary skill in the art, at the time of the invention to have a grinding area in the pad structure of *Watanabe*, because *APA* teaches that this is conventional in the art. One of ordinary skill would be motivated to use conventional methods for separating LCDs in order to save time money and labor in research and development." While the obviousness in patent law recognizes that R&D would be facilitated by looking to the prior art,

obviousness also requires that there must be a motivation or suggestion in the prior art to modify the prior art to include the specific feature out of all the features taught in the prior art. As such, Applicants note that MPEP 2143.01 teaches that “[t]he mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” While the Office Action has asserted that it is desirable to look to the prior art (i.e., the Final Office Action asserts that looking to the prior art saves time, money, and labor in R&D), the Final Office Action has not indicated why it would be desirable to modify the teachings of *Watanabe et al.* and/or *Endo et al.* to specifically include a grinding area.

In the Amendment filed July 14, 2004, Applicants respectfully asserted that the Office Action has cited no motivation in the prior art to modify the teachings of the primary reference in that Office Action with those of Applicants’ allegedly admitted prior art. Apparently, there is some confusion as to what Applicants intended to “proffer.” Applicants merely intended to proffer that the Examiner bears the initial burden of factually supporting an prima facie conclusion of obviousness.” (See MPEP 2142.) Thus, Applicants respectfully requested that documentary evidence of the Office Action’s assertions be provided. In response, the Final Office Action cited several articles as documentary evidence. However, these articles do not discuss grinding areas whatsoever and do not provide any teaching that a grinding area (of all the various LCD features taught in the prior art) would be desirable in the structures taught by *Watanabe et al.* and/or *Endo et al.* Moreover, none of these cited articles are prior art. (See respective dates of these articles relative to the filing date of the present application.)

Accordingly, if the rejection is to be maintained, Applicants respectfully request that timely and topical documentary evidence of the Final Office Action's assertions be provided.

Page 6 of the Final Office Action asserts that "[o]ne of ordinary skill would be motivated to omit other layers from this area to speed up and simplify the grinding process by grinding through only the substrate material as opposed to a plurality of other layers." Contrary to the Final Office Action's assertion, as shown in Figure 4C of the present application, the other layers are not omitted in the grinding area but formed in the grinding area. Moreover, the substrate is not subjected to grinding as asserted by the Final Office Action. Instead, it is the other layer layers that are subject to grinding. As a result, the additional step of forming and then removing the layers by grinding causes additional steps, and therefore, does not speed up or simplify the process as asserted by the Final Office Action.

In addition, while applicants have presented Figures 1 and 2 as relating to a "conventional" art, it is not intended to suggest that all LCD pad structures use a grinding area. while the use of a grinding area is one type of structure conventionally used, it is not the only type of structure conventionally used. Applicants respectfully submit that it appears that *Endo et al.* relates to a different structure convention than that of Applicants' allegedly admitted prior art because it appears to be of a type that does not use a grinding area. (For example, while automatic transmissions are conventional in the automotive arts, not all automobile use automatic transmissions and there would be no necessary reason to apply automatic transmission techniques in manual transmission automobiles because the two use different conventions.)

Further, Applicants respectfully assert that the presence of the grinding area is related to the present invention in that the use of a grinding area introduces problems. Specifically, a part of the inventive process included the recognition that the exposed ends of the grinding portion increases the possibility of atmospheric corrosion or electrolytic corrosion, thereby leading to damage of the pad. Consequently, the present invention seeks, in part, to overcome these problems. However, without a grinding area, the structures of *Watanabe et al.* and/or *Endo et al.* would not be affected by such problems, and therefore, one of ordinary skill in the art would not be motivated to modify or combine these references to achieve the claimed invention.

Thus, Applicants respectfully asserts that the Office Action has improperly asserted obviousness without a suggestion or motivation in the prior art. MPEP § 2145(X)(C) instructs that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.” Also, MPEP § 2143.01 instructs that “a statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App & Iner. 1993).”

Moreover, if one attempted to apply the grinding process of APA Figures 1 and 2 to the device of *Watanabe et al.* and/or *Endo et al.*, one would not achieve the claimed invention. Specifically, the grinding process, as taught by APA Figures 1 and 2, is used to terminate the pad

contact area, thereby exposing the end portion of the pads. Thus, the teachings *Watanabe et al.* and/or *Endo et al.* cannot be simply modified with the teachings of APA Figures 1 and 2 to achieve the claimed invention. The present invention recognizes the problems caused by the APA grinding process and then introduces a technique of applying a grinding to correct the problems.

Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because the applied art does not teach or suggest each feature of independent claims 6 and 19-20. Furthermore, Applicants respectfully assert that dependent claims 7-9 are allowable at least because of their respective dependence from independent claim 6, and the reasons set forth above.

Conclusion

In view of the foregoing, Applicants respectfully entry of the amendments to place the application in clear condition for allowance or, alternatively, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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